

Application No. 10/051,486  
Attorney Docket 24457B

REMARKS

Claims 1, 7, 12, and 21-24 have been amended without prejudice or disclaimer. The amendments were not made to overcome a prior art rejection. No new matter has been introduced. Forty-five (45) claims are pending and remain for consideration. Favorable reconsideration of the pending claims and further examination of the application is respectfully requested.

35 U.S.C. § 103

Claims 1-6, 7-11 and 22 are rejected under 35 U.S.C. § 103, as being unpatentable over U.S. Patent No. 5,666,776, to Weaver et al., in view of U.S. Patent No. 1,915,964, to Wall, and U.S. Patent No. 4,274,243, to Corbin et al. This rejection is respectfully traversed.

Although these claims are rejected in three separate rejections, each rejection relies on the same combination of references (i.e., Weaver, Wall and Corbin). Therefore, the rejections are traversed together in view of the following remarks.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 1, 7, and 22 each recites a *roofing shingle* overlay with tabs having a *first shadow line* and a remaining portion with granules disposed thereon in a manner whereby the first shadow line is substantially *darker in color* than the remaining portion.

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As admitted by the Examiner, on page 3 of the Official Letter, Weaver *fails to show* a tab having a *first shadow line* and a remaining portion, and a layer of granules on the first shadow line and on the remaining portion of the tabs, wherein the granules on the first shadow line of the tabs are substantially *darker in color* than the granules on the remaining portion of the tabs.

To overcome the deficiencies in Weaver, the Examiner relies on Wall, asserting that Wall shows strips with tabs with a first shadow line and a remaining portion. However, Wall teaches a granular covered siding material having a pattern of bricks and mortar joints. Wall *fails to teach* a roofing shingle having a *tab* with a *shadow line* that is *darker in color* than a remaining portion of the tab. To this end, Weaver and Wall, when combined, *fail to teach* all the limitations of claims 1, 7, and 22.

Corbin teaches a randomly varying series of differently colored portions of a granule covered surface. Corbin *fails to teach* a tab having a *first shadow line* that is *darker in color* than a remaining portion of the tab. In this way, Corbin fails to cure the deficiencies in Weaver and Wall, as set forth above. Hence, Weaver, Wall, and Corbin, when combined, do not result in a combination including all the limitations of claims 1, 7, and 22. As a consequence, claims 1, 7, and 22 are non-obvious under 35 U.S.C. §103, and should be patentable.

If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Claims 2-6 and 8-11 depend from claims 1 and 7, respectively, and should be allowable for at least the same reasons as claims 1 and 7, as set forth above.

Claims 12-20 are rejected under 35 U.S.C. § 103, as being unpatentable over Weaver in view of Wall and Corbin. Favorable reconsideration of claim 12 is respectfully requested.

Claim 12 recites a method of making a laminated roofing shingle. The method comprises the steps of applying darker granules to a leading edge of tabs and applying lighter colored granules to a remaining portion of the tabs *so that the leading edge is generally darker in color than the remaining portion*.

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Weaver *fails to teach* steps whereby granules are applied to a leading edge of tabs so that the leading edge of the tabs is generally darker in color than a remaining portion of the tabs, as recited in amended claim 12.

Wall teaches a granular covered siding material having a pattern of bricks and mortar joints. Wall *fails to teach* steps whereby granules are applied to a leading edge of tabs so that the leading edge is generally darker in color than a remaining portion of the tabs. To this end, Weaver and Wall, when combined, *fail to teach* all the limitations of claim 12.

Corbin teaches the step of dropping granules to form color bands but the bands are applied transverse to leading and trailing edges of a shingle, as clearly described in col. 12, lines 4-51, with reference to Fig. 7. Corbin *fails to teach* steps whereby granules are applied to a leading edge of tabs so that the leading edge of the tabs is generally darker in color than a remaining portion of the tabs. Consequently, Weaver, Wall and Corbin, when combined, *fail to teach* the invention recited in claim 12. Hence, claim 12 is non-obvious under 35 U.S.C. § 103 and thus should be patentable.

Claims 13-20 depend from claim 12 and should be allowable for at least the same reasons as claim 12, as set forth above.

Claims 21 and 23 are rejected under 35 U.S.C. § 103, as being unpatentable over Weaver in view of Wall and Corbin. This rejection is respectfully traversed.

Claim 21 recites an overlay with a leading edge having granules thereon, wherein the leading edge is generally *darker* than a remaining portion of the overlay.

Weaver *fails to teach* an overlay with a leading edge having granules thereon, wherein the leading edge is generally *darker* than a remaining portion of the overlay.

Wall teaches a granular covered siding material having a pattern of bricks and mortar joints. Wall *fails to teach* an overlay with a leading edge having granules thereon, wherein the leading edge is generally *darker* than a remaining portion of the overlay. To this end, Weaver and Wall, when combined, *fail to teach* all the limitations of claim 21.

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Corbin teaches a randomly varying series of differently colored portions of a granule covered surface. Corbin *fails to teach* an overlay with a *leading edge* having granules thereon, wherein the leading edge is generally *darker* than a remaining portion of the overlay. Consequently, Weaver, Wall and Corbin, when combined, *fail to teach* the invention recited in claim 21. Hence, claim 21 is non-obvious under 35 U.S.C. § 103 and thus should be patentable.

Claim 23 recites a tab having a *first shadow line* and a remaining portion with a layer of granules disposed thereon in a manner whereby the first shadow line is a *different color or shade* than the remaining portion.

Weaver *fails to teach* a tab having a *first shadow line* and a remaining portion with a layer of granules disposed thereon in a manner whereby the first shadow line is a *different color or shade* than the remaining portion.

Wall teaches a granular covered siding material having a pattern of bricks and mortar joints. Wall *fails to teach* a tab having a *first shadow line* and a remaining portion with a layer of granules disposed thereon in a manner whereby the first shadow line is a *different color or shade* than the remaining portion. Hence, Weaver and Wall, when combined, *fail to teach* all the limitations of claim 23.

Corbin teaches a randomly varying series of differently colored portions of a granule covered surface. Corbin *fails to teach* a tab having a *first shadow line* and a remaining portion with a layer of granules disposed thereon in a manner whereby the first shadow line is a *different color or shade* than the remaining portion. Hence, Weaver, Wall and Corbin, when combined, *fail to teach* the invention recited in claim 23. Hence, claim 23 is non-obvious under 35 U.S.C. § 103 and thus should be patentable.

Claims 24 and 26-32 are rejected under 35 U.S.C. § 103, as being unpatentable over Weaver in view of Wall and Corbin. This rejection is respectfully traversed.

Claim 24 recites an overlay having a tab having two colored portions, each being a different coloration or shade than the other, and an underlay, each having two colored portions, each being a different coloration or shade than the other.

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None of the cited references, separately or combined, teach an overlay having a tab having two colored portions, each being a different coloration or shade than the other, and an underlay having two colored portions, each being a different coloration or shade than the other. Consequently, the invention is non-obvious under 35 U.S.C. § 103 and thus should be patentable.

Claims 25-33 depend from claim 24 and should be allowable for at least the same reasons as claim 24, as set forth above.

Claims 34-45 are rejected under 35 U.S.C. § 103, as being unpatentable over Weaver in view of Wall and Corbin. This rejection is respectfully traversed.

Claim 34 is similar to claim 24 in that claim 34 recites adjacent portions of a tab and adjacent portions of an underlay that are a different shade or coloration. Claim 34 should be allowable for at least the same reasons as claim 24, as set forth above.

Claims 34-45 depend from claim 34 and should be allowable for at least the same reasons as claim 34, as set forth above.

In view of the foregoing remarks and arguments, it is believed that all the claims are in condition for allowance. Favorable reconsideration of the claims is respectfully requested.